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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,134	07/15/2003	Mark Roby	2853	7844

7590 01/19/2006

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EXAMINER

GEHMAN, BRYON P

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

7/25

Office Action Summary

Application No.

10/620,134

Applicant(s)

ROBY ET AL.

Examiner

Bryon P. Gehman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6-8 and 10-19 is/are pending in the application.
- 4a) Of the above claim(s) 6-8 and 10-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Erickson (3,819,039). Claims 1-2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Zatarga (5,582,288). Claims 1-2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Roshdy et al. (6,739,450). Each discloses an apparatus inherently capable of fixating a suture in a substantially perpendicular orientation relative to a pledget, the structure claimed comprising a block (10; 18; 30; respectively) having first and second slits (any two of 22-25; 42, 44; two adjacent slits 32 approaching the pledget 16) to engage a portion of a first end portion of a suture (at or near 13; 12 at 18; 12 at 16) and at least a portion of a second end of the suture (at or near 14; 12 at 18 in the Figure; 12 at 16) so as to maintain a suture and pledget orientation should a suture and pledget be secured thereto. Applicants, while mentioning a pledget in the preamble, never define the pledget as part of the claimed invention and each subsequent reference to "the pledget" is considered to be a reference to the mentioned but unincorporated imaginary pledget. The recitation "for fixating a suture in a substantially perpendicular orientation relative to a pledget" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the

purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Further evidence that applicants do not include a suture nor a pledget as part of their invention is further evidenced in the use of "adapted to..." in lines 5 and 6. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. **If the prior art structure is capable of performing the intended use, then it meets the claim.** See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Absent the pledget, there is no distinguishment of the block of the prior art from the applicants' block.

As to claim 2, each discloses the at least one slit capable of maintaining a parallel relationship between end portions of the suture (the end portions being arbitrary; see the Figure at 18).

As to claim 4, each discloses a first face (15; shown upper side), a second face (16; shown lower side) and a top face (11; containing the slits).

3. Applicant's arguments filed December 22, 2005 have been fully considered but they are not persuasive. Since claims 1-2 and 4 include neither a suture nor a pledget, but encompass structures absent a suture and pledget that could so act, the arguments

relative to an arrangement and structure of the pledget and suture remain unconvincing. Furthermore, Zatarga and Roshdy et al. each disclose a suture (12; 12) and a pledget (32; 16) arranged as intended but not claimed.

Applicants are basically claiming a block having two adjacent slits therein capable of holding a suture.

4. This action is made non-final in view of the new grounds incorporating Roshdy et al..

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Monday through Wednesday from 5:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Bryon P. Gehman". The signature is fluid and cursive, with the first name "Bryon" being more prominent.

Bryon P. Gehman
Primary Examiner
Art Unit 3728

BPG